

Claim 10. (Twice Amended). A process for preparing a liquid coating composition comprising the steps of mixing:

- C1
- i) diphenylmethane diisocyanate, and
 - ii) a hydroxyl functional compound which is a polyester having secondary hydroxyl groups, the secondary hydroxyl groups being the product of a reaction between a carboxylic acid group and an epoxide group comprising a glycidyl ester of a C11-C20 alkanolic acid, optionally dissolved in organic solvent.

Amended Claim 10 does not contain new matter and support for the amendment is found in the patent application as originally filed. A marked up version of amended Claim 10 appears in the attached Appendix.

REMARKS

In the Office Communication mailed on May 8, 2002, the Examiner stated that PPG's reply filed on February 8, 2002 to an Office Action mailed on October 16, 2001, was not fully responsive because the rejection of independent Claim 10 was not addressed. In the Office Communication, the Examiner also stated that the Applicants failed to indicate where adequate support exists for the claim amendments pertaining to "liquid".

Remarks relating to Amended Claim 10

As shown above, Claim 10 has been amended to place it in conformance with the rest of the claims in the patent application which were previously amended in the Response mailed on January 16, 2002. The arguments contained in the Response mailed on January 16, 2002 concerning the traversal of claim rejections apply to amended Claim 10 when relevant.

Support for the Claim Amendments pertaining to "Liquid"

Support for the claim amendments which restrict the inventive compositions to "liquid" compositions appear throughout the application as originally filed. As stated on

page 3, line 5 of the patent application, good pot-life is a major benefit of the present invention. Pot-life is a characteristic of liquid compositions. As discussed on page 2, line 3 of the application, the term "pot-life" refers to the amount of time a composition has a **viscosity** which allows the composition to be usable. The term "viscosity" is defined as the resistance of a **liquid** to sheer forces (and hence to flow) in *WordNet® 1. 6, © 1997 Princeton University*.

Another indication that the inventive composition is a liquid comes from the application techniques discussed in the application. Page 6, line 1 reads "The coating composition can be applied by conventional means such as by brush, roller or spray". Such application techniques are typically used for liquid compositions.

Further, the liquid state of compositions according to the present invention can be inferred from various language in the patent application. For example, page 5, line 1 reads "The reaction between the polyfunctional carboxylic acid and the monoepoxide can be carried out by adding the monoepoxide to a **solution** of the polycarboxylic acid in a suitable **organic solvent** in an amount so as to react each of the hydroxyl groups on the polyol with an epoxide group, and heating the mixture to between about 130 and 160°C for between about 2 and 12 hours. The terms "solution" and "organic solvent" infer the composition is a liquid.

CONCLUSION

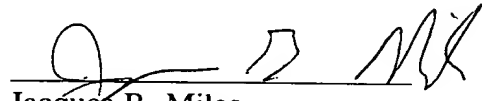
Please consider this Supplemental Amendment in conjunction with the Response mailed on January 16, 2002. The Amendment in combination with the Response filed on January 16, 2002 address all of the rejections contained in the Office Action mailed on October 16, 2001. Considering the claim amendments and remarks made in response to the Office Action, the present application is now in condition for allowance. The Applicants respectfully request reconsideration and withdrawal of the following rejections: (1) the rejection of claims 1-4, 6-9, and 11 under 35 U.S.C. § 112, second paragraph; (2) the rejection of claims 1-11 under 35 U.S.C. § 102(b) as being anticipated by WO97/30099 or NL 9201868; (3) the rejection of claims 1-4 and 6-11 under 35 U.S.C. § 102(b) as being

anticipated by Chattha ('906) or Peng ('508); and (4) the rejection of claims 1-11 under 35 U.S.C. § 102(b) as being anticipated by WO96/20968.

If you have any questions, please give me a call at the telephone number listed below.

Respectfully submitted,

Date: June 7, 2002



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APPENDIX

MARKED UP VERSION OF AMENDED CLAIM 10

Claim 10. (Twice Amended) A process for preparing a liquid coating composition comprising the steps of mixing:

- i) diphenylmethane diisocyanate, and
- ii) a hydroxyl functional compound which is a polyester having secondary hydroxyl groups, the secondary hydroxyl groups being the product of a reaction between a carboxylic acid group and an epoxide group comprising a glycidyl ester of a C11-C20 alkanolic acid, optionally dissolved in organic solvent.

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JUN 19 2002
TC 1700